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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/761,763	01/18/2001	Kevin M. Sullivan	47004.000086	5922
21967	7590	09/30/2004	EXAMINER	
HUNTON & WILLIAMS LLP INTELLECTUAL PROPERTY DEPARTMENT 1900 K STREET, N.W. SUITE 1200 WASHINGTON, DC 20006-1109			CHAMPAGNE, DONALD	
		ART UNIT		PAPER NUMBER
		3622		
DATE MAILED: 09/30/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No.	Applicant(s)	
	09/761,763	SULLIVAN, KEVIN M.	
	Examiner	Art Unit	
	Donald L. Champagne	3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM
 THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 25 June 2004.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-20 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 18 January 2001 is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date: _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>6-25-04</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed with an amendment on 25 June 2004 have been fully considered but they are not persuasive. The arguments are addressed by revisions of the last Office action and explicitly at para. 4-5 and 13-14 below.

Notice of Amendment Error

2. Claim 8 is labeled "Currently Amended", but said claim is in fact in Original form. Applicant need not take immediate action, but should correct the claim status in any future copy of the claims.

Claim Objections

3. Claims 8 and 18 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. The claims add only nonfunctional descriptive matter; see the following para. 4-5. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.
4. Applicant argued (p. 10 last para.) that this objection was improper, and asked for further explanation, particularly in view of the support provided by spec. p. 21 lines 1-14. Applicant has the objection confused with indefiniteness. Both the claims and the cited support are quite clear. The problem is that claims 8 and 18 add only business, ownership or institutional distinctions, distinguishing between "the card provider system" and "the brokerage system". The specification (p. 8 lines 7-20, p. 9 lines 14-21 and p. 9 line 28 to p. 10 line 2) provides a basis for interpreting these terms as indicating ownership, rather than technological, distinctions.
5. Applicant argues further (p. 11 top) that the distinctions made by the claims are meaningful to the involved entities. But that is not at issue. US patents are granted based on technological distinctions, and claims 8 and 18 add no technological distinctions to the parent claims. Also see para. 13-14 below.

Claim Rejections - 35 USC § 102 and 35 USC § 103

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1, 2, 4-12 and 14-20 are rejected under 35 U.S.C. 102(b) as anticipated by Cohen et al. (US pat. 4,750,119, made of record by IDS filed as paper No. 4, 15 March 2001).
9. Cohen et al. teaches (independent claims 1, 2, 9-12, 19 and 20) a system and method for administering a rebate program, the method comprising: providing a card instrument and account (*Individual Consumer Account*) to a *consumer* (card holder) and processing a purchase made by said *consumer*/ cardholder with the card instrument and recording said transaction in the *ICA*/cardholder account (col. 5 lines 6-38); determining *net cost of goods sold* (net purchase information) based on a summation of purchase information stored in the *ICA*/cardholder account and determining rebate information based on said *net cost of goods sold*/net purchase information (col. 1 lines 62-63 and col. 7 lines 12-15); transferring the rebate information to an *escrow agent* (col. 3 lines 66-69), which reads on part of a brokerage service (para. 10 below), wherein the *escrow agent/brokerage service* applies a rebate (*pays the insurance company a premium*) to fund at least part of a transaction made using the brokerage service (*purchasing an aggregate annuity policy*, col. 4 lines 18-21), wherein the rebate is based on the rebate information, wherein the *escrow agent/brokerage service* charges a fee (*administrative fee*, col. 6 lines 21-22) to perform the transaction, and the rebate received by said *escrow agent/brokerage service* paying, which reads on funding, said transaction/*administrative fee* (col. 4 lines 24-29).

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10. No patentable weight was given to the limitations “by the card provider” and “by the brokerage service” in claim 12. These are ownership or institutional distinctions that constitute nonfunctional descriptive material (para. 13-14 below).
11. Applicant argued (p. 13-14) that the *escrow agent* is not a brokerage service, and also that it does not charge a fee to perform a transaction, because the *administrative fee* noted at the last line of para. 8 above is paid to the processing center, not to the *escrow agent*. The examiner interprets the intermediary that the reference calls the *purchasing or processing system or center* to be the “brokerage service”. That is consistent with the definition of “brokerage” (Merriam-Webster’s Online Dictionary). The reference teaches that the *escrow agent* can be part of said *purchasing/processing center/brokerage service* (col. 6 lines 40-41).
12. Cohen et al. also teaches: claims 4, 5, 14 and 15 (col. 4 lines 18-24); and claims 6, 7, 16 and 17, where Fig. 4 is a card instrument report and Fig. 5 is a transaction report.
13. Cohen et al. does not teach (claims 8 and 18) that the rebate is funded in part by each the card provider system and the brokerage system. These “systems” are interpreted as business entities (Merriam-Webster’s Online Dictionary definition of “system” and specification p. 8 lines 7-20, p. 9 lines 14-21 and p. 9 line 28 to p. 10 line 2). These “systems” do not exhibit any functional interrelationship with the way in which computing processes are performed (MPEP 2106.IV.B.1(b), first paragraph). A difference in ownership of institutions is not a practical application within the technological arts. The claimed limitations are not statutory matter (MPEP 2106.IV.B.2(b)).
14. As the specification notes at p. 9 line 28 to p. 10 line 2, ownership of the subject institution(s) can be subdivided and distributed. This does not affect any functional relationships within or between the institution(s). Whether the card provider and the brokerage service are the same or different institutions has no bearing on the functional or technological properties of the invention. “A” can issue credit cards and “B” can broker products whether the two entities are divisions of the same corporation, independent corporations, or corporations associated by some degree of common ownership. In every case, the instant invention can be practiced without functional or technological differences.
15. Claims 3 and 13 are rejected under 35 U.S.C. 103(a) as obvious over Cohen et al. Cohen et al. does not teach that rebate information is determined as a percentage of net purchase

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information. Because it is common to determine commissions, 401(k) contribution limits, etc., as a percentage of some base amount, and therefore familiar and convenient to do so, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add that rebate information is determined as a percentage of net purchase information.

Conclusion

16. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).
17. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.
18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald L Champagne whose telephone number is 703-308-3331. The examiner can normally be reached from 6:30 AM to 5 PM ET, Monday to Thursday. The examiner can also be contacted by e-mail at donald.champagne@uspto.gov, and *informal* fax communications (i.e., communications not to be made of record) may be sent directly to the examiner at 703-746-5536.
19. The examiner's supervisor, Eric Stamber, can be reached on 703-305-8469. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-306-5771.
20. **AFTER FINAL PRACTICE** – Consistent with MPEP § 706.07(f) and 713.09, prosecution generally ends with the final rejection. Examiner will grant an interview after final only when applicant presents compelling evidence that "disposal or clarification for appeal may be accomplished with only nominal further consideration" (MPEP § 713.09). The burden is on

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applicant to demonstrate this requirement, preferably in no more than 25 words.

Amendments are entered after final only when the amendments will clearly simplify issues, or put the case into condition for allowance, clearly and without additional search or more than nominal consideration.

21. Applicant may have after final arguments considered and amendments entered by filing an RCE.

22. **ABANDONMENT** – If examiner cannot by telephone verify applicant's intent to continue prosecution, the application is subject to abandonment six months after mailing of the last Office action. The agent, attorney or applicant point of contact is responsible for assuring that the Office has their telephone number. Agents and attorneys may verify their registration information including telephone number at the Office's web site, www.uspto.gov. At the top of the home page, click on Site Index. Then click on Agent & Attorney Roster in the alphabetic list, and search for your registration by your name or number.

Donald L. Champagne
Primary Examiner
Art Unit 3622

23 September 2004

DONALD L. CHAMPAGNE
PRIMARY EXAMINER

